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EXAMINER	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 22

Application Number: 09/520,402
Filing Date: March 08, 2000
Appellant(s): YOSELOFF, MARK L

YOSELOFF, MARK L
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03/11/03.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-37 stand or fall together on pages 9-11.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,132,311	Williams	08-2000
5,570,885	Ornstein	11-1996
5,868,618	Netley et al.	02-1999
6,179,711	Yoseloff	01-2001

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

In order to determine whether application claims must be found unpatentable over the prior art, the terms and phrases used in the claims must be read in light of the specification. This is necessary to establish whether the meaning of those terms and phrases given by the applicant in the context of the application should be accorded any meaning different from the usual and customary meaning of the claim terms. Here, it is submitted that most of the claim terms, such as "symbols " and "bet", must be given their intrinsic dictionary definition. But some other terms such as "rank" and "payout table" require some scrutiny. A careful review of the specification as filed and especially page 23, lines 1-12, makes it clear that applicant intends a specific payout for a specific rank hand on the table.

Claims 1-19, 22-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (6,132,311) in view of Ornstein (5,570,885).

Williams teaches a method of playing a wagering game with at least at least two plays (abstract line 1), receiving at least one set of symbols (32,36,40), receiving a second set

of symbols (32,36,50), comparing each set to symbols to the payout table (20), determining the ranks of first and second set of symbols whether they exceed a minimum rank ("two pair" in table 20). Resolving the wager with respect to first and second set of symbols (col.7, lines 5-10). Ornstein further teaches deck of playing cards (col.11, lines 21-22), poker ranks (20).

Williams teaches all limitations of these claims except that it does not teach resolving a bet with respect when both first and second set of symbols exceed a minimum rank in the pay table.

Ornstein teaches a method of playing a game where a payoff is made for consecutive winnings (col.2, lines 17-21) and enhanced payoff due to consecutive winnings (col.3, lines 42-47). If a player knows that he would make additional money by winning two or more hands consecutively, he would be more interested in playing that game. Applicant might argue that hands 40 and 50 are not consecutive hands.

One of ordinary skill in art at the time the invention was made would have made the game more attractive for players by making an additional payoff for winning two or more plays consecutively. Examiner takes the position that while practicing the game on a gaming table the turning of cards 40 and 50 would be consecutive (col.11, lines 1-8). Examiner views applicant's variations in pay tables, minimum ranks and number of bets required for hands are choices of game houses and would change according to their financial situations. In order to make the game house profitable, it would have been obvious to change such limitations without changing the scope and spirit of the game.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Netley (5,868,618) in view of Ornstein (5,570,885).

Netley teaches a method of playing a poker game comprising the steps of wagering for each game (col.3, lines 13-14), playing at least two games (abstract), allowed to play a second game if winning the first game (col.2, lines 65-67), awards for winning both hands (col.3, lines 27-31), and bonus (col.3, lines 39).

Netley teaches all limitations of these claims except that it does not teach resolving a bet with respect when both first and second set of symbols exceed a minimum rank in the pay table.

Ornstein teaches a method of playing a game where a payoff is made for consecutive winnings (col.2, lines 17-21) and enhanced payoff due to consecutive winnings (col.3, lines 42-47. If a player knows that he would make additional money by winning two or more hands consecutively, he would be more interested in playing that game.

Applicant might argue that hands 40 and 50 are not consecutive hands.

One of ordinary skill in art at the time the invention was made would have made the game more attractive for players by making an additional payoff for winning two or more plays consecutively. If a player knows that he would make additional money by winning two or more hands consecutively, he would be more interested in playing that game.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4,15,20,23 and 31are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6179711 in view of Ornstein .

Yoseloff teaches all limitations of these claims except that it does not teach resolving a bet with respect when both first and second set of symbols exceed a minimum rank in the pay table.

Ornstein teaches a method of playing a game where a payoff is made for consecutive winnings (col.2, lines 17-21) and enhanced payoff due to consecutive winnings (col.3, lines 42-47. If a player knows that he would make additional money by winning two or more hands consecutively, he would be more interested in playing that game.

Applicant might argue that hands 40 and 50 are not consecutive hands.

One of ordinary skill in art at the time the invention was made would have made the game more attractive for players by making an additional payoff for winning two or more plays consecutively. If a player knows that he would make additional money by winning two or more hands consecutively, he would be more interested in playing that game.

(11) Response to Argument

In page 12, lines 2-3 the applicant alleges that the double patenting rejection does not specify over which claims the prior art 6,471,208 (?) in view of Ornstein.

Examiner has clearly indicated in page 4 of office action mailed on 11/4/02 that claims are rejected over claim 1 of Patent 6,179,711 in view of Ornstein.

Applicant has also erroneously referred to Patent 6,471,208 as opposed to the cited Patent 6,179,711 that is in the rejection.

In page 12, lines 6-8 the applicant has offered to provide a Terminal disclaimer, however until then it does not obviate the double patenting rejection.

In page 12, line 10 through page 15, line 13 the applicant argument that the double patenting of claims 1,4,15,20,23 and 31 is in error is not persuasive.

Firstly the applicant is basing the arguments erroneously referring to patent 6,471,208. This patent is not a cited reference. The cited reference is Patent 6,179,711.

Secondly the applicant's arguments are not understood in highlighting limitations in patent claims that are not present in the in the play or in applicant's claims and I providing reasons why they are not present in applicant's claims. The real question is "are there any limitations in applicant's claims that are not present in patent claims that would be considered patentable?"

Applicant's argument in page 16, line18-21 that Williams in view of Ornstein does not teach playing a second game without placing a second wager is not persuasive.

Williams clearly teaches (see Williams abstract lines 1-3) player making a wager to play two or more hands.

With regards to applicant's arguments in page 17, lines 9-10 that the secondary reference Ornstein does not relate to ranks. Examiner takes the position that the rejection does not rely on whether the secondary reference relates or does not relate to ranking system, but whether it supplements or not what the primary reference lacks. The primary reference only lacks payouts for winning consecutive hands regardless of the use of such a method being used for playing poker, blackjack or a dice game. In the rejection the difference is in the limitation of winning enhanced payout for winning consecutive hands. Ornstein clearly teaches winning enhanced payout for winning consecutive hands (see Ornstein 3:42-47).

With regards to arguments regarding claims 3, Williams clearly teaches wining with minimum ranks (20).

With regards to arguments regarding claims 4-11, intended use of a method step having a symbol is same as cards because cards have symbols too.

With regards to claims 15,16 playing video games is intended use of the method and does not change the method in essence.

With regards to claims 17, 18: Ornstein clearly teaches enhanced payout for two or more consecutive winnings.

With regards to claim 19: Williams teaches paytable (20)

With regards to claims 22-25,28-37: see rejection of claim 1, 22 and 23.

With regards to claim 26: Playing slot game is only an intended use of the method in essence.

With regards to claim 27: Ornstein teaches an embodiment where player's hand is compared with dealer's hand for playing blackjack (3:42-47).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Ben Layno
Primary Examiner

VKM
May 21, 2003

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Paul Sewell SPE ....

Vishu Mendiratta Examiner...

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